UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,548	12/27/2001	Katsuhito Kitahara	P6393a	7498

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EXAMINER
LAM, ANDREW H

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/033,548	KITAHARA ET AL.
	Examiner	Art Unit	
	Andrew H. Lam	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 October 2006</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-29* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on

  10/18/06.

- Claims 1-29 are pending in the present application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-

Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office

describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls

within one of the three following categories of unpatentable subject matter: (1)

Functional descriptive material such as a data structure per se or a computer program

per se, (2) Non-functional descriptive material such as music, literary works or pure

data, embodied on a computer readable medium; or (3) A natural phenomenon such as

energy or magnetism. The invention as defined by the claims is not a natural

phenomenon or pure data, however, it is a computer program per se, which does not

mount/store on any computer-readable medium; therefore, these claims are rejected for

non-statutory basis.

Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The program claimed is merely a set of

instructions per se. Since the computer program is merely a set of instructions not

embodied on a computer readable medium to realize the computer program

functionality, the claimed subject matter is non-statutory. The examiner recommends

the applicants to replace "a data storage medium embodying a program " with "a

computer readable medium storing a computer readable program" so it compliances

with 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 14-25 are rejected under 35 U.S.C. 102(b) as being anticipated

by Sansone (U.S. Patent No. 5,890,818) hereinafter Sansone.

Regarding claim 1, Sansone discloses an apparatus for generating logo data to

be stored in and printed by a printer (col. 4, lines 66-col. 5, lines 10), the apparatus

comprising (see fig. 12): a control data receiving unit configured (see fig. 11, printer

compatibility list, printer setting list, barcode data 350) to receive control data including

specific settings data and model identification data identifying a model of at least one

target printer in which the logo data is to be stored (col. 5, lines 11-col. 6, lines 56 and

col. 8, lines 28-64); a source data obtaining unit configured to obtain source data used

to generate the logo data (col. 6, lines 44-56); a reading unit configured to read, based

on the model identification data, model-specific data for the at least one target printer

from respective model-specific data stored for a plurality of printer models (col. 5, lines

11-col. 6, lines 56 and col. 8, lines 28-64); a logo data generating unit configured to

generate the logo data by processing the source data based on the model-specific data

read by the reading unit or on control data received by the control data receiving unit

(col. 5, lines 11-col. 6, lines 56, and col. 7, lines 31-47); and a storage unit configured to

store the logo data generated by the logo data generating unit (col. 6, lines 62-col. 7,

line 47) .

Regarding claim 2, Sansone discloses an apparatus as described in claim 1,

wherein the control data is limited to model-specific data that can be identified by the

model identification data (col. 5, lines 11-col. 6, line 56 and col. 8, lines 28-64).

Regarding claim 3, Sansone discloses an apparatus as described in claim 2,

wherein the control data receiving unit is adapted to disable receipt of at least some

data for which setting is not required based on previously received or set control data

(col. 5, line 11-col. 6, line 56 and col. 8, lines 28-64).

Regarding claim 4, Sansone discloses an apparatus as described in claim 3,

wherein at least some control data are initialized to respective specific values that can

be changed based on other control data received from the control data receiving unit

(col. 5, line 11-col 6, lines 56 and col. 8, lines 28-64)

Regarding claim 5, Sansone discloses an apparatus as described in claim 4,

wherein the control data receiving unit is adapted to enable specifying colors available

for printing in, the at least one target printer (col. 5, line 11-col. 6, line 56, and col. 8,

lines 28-64).

Regarding claim 6, Sansone discloses an apparatus as described in claim 5,

wherein the logo data generating unit is adapted to assign source data colors to specific

colors printable by the at least one target printer based on the model-specific data and

settings data (col. 5, line 11-col. 6, line 56, and col. 8, lines 28-64).

Regarding claim 7, Sansone discloses an apparatus as described in claim 6,

wherein the stored model-specific data includes communications parameters for each of

the plurality of printer models, and the reading unit is adapted to set communications

parameters for sending logo data to the at least one target printer based on the model-

specific data (col. 5, line 11-col. 6, line 56 and col. 7, line 31-col. 8, line 64).

Regarding claim 8, Sansone discloses an apparatus as described in claim 7,

further comprising an output unit configured to output the generated logo data (col. 8,

line 37-col. 9, line 40), the output unit being adapted to output a file containing the logo

data, a printer registration command for storing the logo data in the at least one target

printer, and a data transmission command for sending the printer registration command

and logo data to the at least one target printer (col. 5, line 11-col. 6, line 56 and col. 7,

line 31-col. 8, line 64).

Regarding claim 9, Sansone discloses an apparatus as described in 7, further

comprising an output unit configured to output the generated logo data (col. 8, line 37-

col. 9, line 40), the output unit being adapted to send the logo data and a command that

causes the at least one target printer to store the logo data therein (col. 8, line 37-col. 9, line 40).

Regarding claim 10, Sansone discloses an apparatus as described in claim 1, wherein the control data receiving unit has a graphical user interface input function (col. 5, line 11-col. 8, line 64, being inherent in the computer 42).

Regarding claim 11, Sansone discloses an apparatus as described in claim 10, wherein the control data receiving unit does not display input items for which setting is not required based on received or set control data (col. 6, line 26-col. 7, line 30).

Regarding claim 12, Sansone discloses an apparatus as described in claim 11, further comprising a display adapted to display an image based on the source data and an image based on data after processing by the logo data generating unit (col. 6, line 26-col. 7, line 30).

Regarding claims 14-25, the claims recite limitations that are similar and in the same scope of invention as to those in claims 1-12 above and combination thereof; therefore, claims 14-25 are rejected for the same rejection rationale/basis as described in claims 1-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Sansone in view of Goring (U.S. Patent Pub. 2002/0077892) hereinafter Goring.

Regarding claim 13, Sansone discloses the apparatus described above in claim

12, but fails to expressly disclose that the display is adapted to display the image

aligned for comparison on one side of the display.

Goring discloses an apparatus for generating logo data to be stored in and

printed by a printer (see abstract), the apparatus comprising a control data receiving

unit configured to receive control data including specific settings data identifying a

model of at least one target primer in which the logo data is to be stored (paragraphs

0015-0020), a source data obtaining unit configured to obtain source data used to

generate the logo data, a reading unit configured to read, based on the settings, model-

specific data for the at least one target printer from respective model-specific data

stored for a plurality of printer models (paragraphs 0013-0018), a logo data generating

unit configured to generate the logo data by processing the source data based on the

model-specific data read by the reading unit or on control data received by the control

data receiving unit (paragraphs 0018-0020), and a storage unit configured to store the

logo data generated by the logo data generating unit (paragraphs 0018-0020, and 0024-

0025). Further, Goring teaches that the display is adapted to display the images aligned

for comparison on one side of the display (paragraphs 0018-0023).

Sansone & Goring are combinable because they are from the same field of

endeavor, being systems that generate advertising data on a printer. At the time of the

invention, it would have been obvious to a person of ordinary skill in the art to display

the images aligned for comparison on one side of the display, as taught by Goring,

within the system of Sansone. The suggestion/motivation for doing so would have been

that Sansone's system would become more user-friendly with the addition of Goring's

teachings, as various graphic placement settings would be customizable, thereby

increasing the advertising impact, as recognized by Goring in paragraphs 0014-0018.

Therefore, it would have been obvious to combine the teachings of Goring with system

of Sansone to obtain the invention as specified in claim 13.

Regarding claim 26, Sansone discloses a logo data generating system (column

4, line 66-column 6, line 3), comprising memory for storing a printer model name and a

predetermined number of printable colors, and print resolution of the printer model

(column 5, line 11-column 6, line 56, and column 8, lines 28-64), a reading unit for

reading source data to obtain image data provided for printing as logo data (column 5,

line 11-column 6, line 56, and column 7, lines 31-47), a display unit for reading and

displaying data stored in memory (column 6, line 26-column 7, line 30), a selection unit

for selecting a target printer for printing out the logo data from among the printer model

names displayed on the display unit (column 5, line 11-column 6, line 56, and column 8,

lines 28-64), and a logo data generating unit for processing the source data to create

logo data for printing based on the model name of the target printer selected by the

selection unit and the number of printable colors, and print resolution of the selected

target (column 5, line 11-column 6, line 56, and column 7, lines 31-47).

However, Sansone fails to expressly disclose of a display unit for reading and displaying the printer model name, number of printable colors, and print resolution stored in memory.

Goring discloses a logo data generating system (see abstract), comprising memory for storing a predetermined number of printable colors, and print resolution of the printer (paragraphs 0015-0018), a reading unit for reading source data to obtain image data provided for printing as logo data (paragraphs 0013-0018), a display unit for reading and displaying the printer model name, number of printable colors, and print resolution stored in memory (paragraphs O013-0019), a selection unit for selecting a target printer for printing out the logo data from among the printer model names displayed on the display unit (paragraphs O013-0020), and a logo data generating unit for processing the source data to create logo data for printing based on the model name of the target printer selected by the selection unit and the number of printable colors, and print resolution of the selected target (paragraphs O013-0020).

Sansone & Goring are combinable because they are from the same field of endeavor, being systems that generate advertising data on a printer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store the advertising data as taught by Goring within the system of Sansone. The suggestion/motivation for doing so would have been that Sansone's system would become more user-friendly with the addition of Goring's teachings, as various attributes would be customizable, thereby increasing the advertising impact, as recognized by Goring in paragraph 0014. Therefore, it would have been obvious to combine the

teachings of Goring with system of Sansone to obtain the invention as specified in claim 26.

Regarding claim 27, Sansone and Goring disclose the system described above in claim 26, and Sansone further teaches of a data transmission unit for sending the logo data generated by the logo data generating unit to the target printer (column 5, line 11-column 6, line 56, and column 8, lines 28-64).

Regarding claim 28, Sansone and Goring disclose the system described above in claim 26, and Goring further teaches of a second memory for storing the logo data generated by the logo data generating unit (paragraphs 0018-0020, and 0024-0025).

Sansone & Goring are combinable because they are from the same field of endeavor, being systems that generate advertising data on a printer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store the advertising data as taught by Goring within the system of Sansone. The suggestion/motivation for doing so would have been that Sansone's system would become more efficient with the addition of Goring's teachings, as the terminal would not need to download a further copy of a logo on subsequent printing requests, as recognized by Goring in 0008-0012. Therefore, it would have been obvious to combine the teachings of Goring with system of Sansone to obtain the invention as specified in claim 27.

Regarding claim 29, Sansone and Goring disclose the system described above in claim 26, and Goring further teaches that the memory stores paper width attributes of the printer model, the display unit displays the stored paper width attributes, and the

logo data generating unit processes the source data to create logo data for printing also based on the paper width attributes of the selected target printer (paragraphs 0018-0020, and 0024-0025).

Sansone & Goring are combinable because they are from the same field of endeavor, being systems that generate advertising data on a printer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store the advertising data as taught by Goring within the system of Sansone. The suggestion/motivation for doing so would have been that Sansone's system would become more efficient with the addition of Goring's teachings, as the terminal would not need to download a further copy of a logo on subsequent printing requests, as recognized by Goring in 0008-0012. Therefore, it would have been obvious to combine the teachings of Goring with system of Sansone to obtain the invention as specified in claim 29.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gulati (U.S. Patent Number 6,525,835) discloses a system for label generation.

Ebner et al. (U.S. Patent No 5,452,094) discloses a system for generating logo and storing the logo at the target printer for later usage.

Ebner et al. (E.P. Pub. No 596,706) discloses a system for generating logo and storing the logo at the target printer for later usage.

Response to Arguments

Applicant's arguments, see pages 6-7, filed 10/18/06, with respect to the rejection(s)of claim(s) 1-12 and 14-25 under 102(b) and claims 13 and 26-29 under 103(a) have been fully considered and are not persuasive.

Regarding claims 1, 14, 20 and 26, the applicant argued the cited prior arts (U.S. Patent No. 5,890,818, Sansone) fails to teach and/or suggest "a system in which the logo data is stored in the printer and used when a logo print command is sent to the printer".

In response to applicant's argument Sansone discloses an apparatus for generating logo data to be stored in and printed by a printer (col. 4, lines 66-col. 5, lines 10), more specifically in col. 57-65, the computer 41 receives information about the printers, printer settings, inks or toners and papers that have been found to be compatible with the printing of indicia 43 from computer 52. Furthermore, in col. 6, lines 38-65, if the printer listed on the initiating files does not contains the updated information such as dither setting, graphic setting, resolution enhancement technology setting, paper identification, toner identification of the printer 42 a request for information containing in the initiating file is updated wherein it is stored in the computer database and is sent to the printer.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, the examiner would like to point out that as

stated in the independent claims 1, 14, 20 and 26, the storage unit as claimed is

interpreted as in the apparatus which is the computer 41.

Contact Information

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-

8569. The examiner can normally be reached on M-F (9:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Lam   12/16/06

K A Williams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER